GP 3764

Atty. Docket No. 156.0001

PATENT

5-31-00

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : STAN SCHALL, JR.

Serial No. : 09/310,965 Examiner: J. Saydah

Filed : May 13, 1999 Group Art Unit: 3764

For : EXERCISE APPARATUS

RESPONSE TO RESTICTION/ ELECTION REQUIREMENT

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This paper is being filed in response to the Restriction/Election Requirement mailed on November 22, 1999. This Response is timely, as a shortened statutory period was not indicated on the Office Action Summary page.

Pursuant to that Office Action and 37 C.F.R. §1.143, Applicant elects the Group I claims 1-11 and 13. Applicant further elects claims 1-4, 6-10 and 13 directed to species 1 as embodied in Figure 4.

Applicant respectfully traverses this restriction/election requirement as being improper under MPEP §§803, 806.05(c), and 808.02. Applicant, however, does not admit or imply that any of the claims are obvious over any other pending claim in this patent application.

The Office Action states that both claim groups I and II are classified within class 482, subclass 141 and that both groups are exercise devices within the second paragraph on page 2. Applicant respectfully asserts that the requirements set forth in MPEP §808.02 have not been met.

MPEP §808.02 requires that when

> the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

The Examiner has admitted in the Office Action that all of the claims are within the same class and subclass, which satisfies the first prong of MPEP §808.02. The second prong of MPEP §808.02 is met, because the field of search for these two groups will be the same such that a search for one or the other will likely be in the appropriate art for the non-search group as they both relate to exercise devices. The Examiner has made no clear indication of separate future classification for these two groups. Thus, this restriction requirement was improper.

Another reason for withdrawing the restriction/election requirement is that examination of the patent application would be most expeditious by examining all pending claims together. As MPEP §803 requires,

> [i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and/or independent inventions.

The restriction requirement is improper, because the Examiner has not shown that a search and examination of the entire application would, indeed, cause a serious burden, as required by MPEP §803 for proper restriction. In fact, a serious burden would arise only if examination of the patent application were restricted to one of the claim groups. Filing an additional patent application containing the non-elected claims would unnecessarily burden (1) the Patent and Trademark Office, since it must assume the additional labor involved in examining at least two separate applications; (2) the public, since it will have to analyze at least two patents (assuming the subject matter of each claim group is found patentable) to ascertain all of the claimed subject matter; and (3) the Applicants, since the Applicants must bear the substantial financial burden and

delays associated with prosecution of multiple patent applications and the payment of maintenance fees for multiple patents.

Applicant respectfully requests that the Examiner withdraw the restriction/election requirement and proceed on the merits for all of the pending claims.

Respectfully submitted,
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May 22, 2000